

Remarks/Arguments

Applicants have received and carefully reviewed the Office Action of the Examiner mailed September 8, 2006. Claims 1-6, 8-26 and 28-36 remain pending. Reconsideration and reexamination are respectfully requested.

Rejection under 35 U.S.C. § 112, first paragraph

Claims 1-6, 8-26, and 28-36 are rejected as failing to comply with the enablement requirement because the specification does not describe "textual matter." Applicants respectfully traverse the rejection. Applicants note that claims 25, 26, 28-30, and 36 do not recite "textual matter," thus the inclusion of these claims in the rejection appears to be clearly improper. MPEP 2164.01 provides the test of enablement:

Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

(Emphasis added). Applicants submit that the disclosure provides sufficient information so that one of ordinary skill in the art would be able to perform the claimed method step of providing marketing material that includes textual matter, and that providing textual material would not require undue experimentation. It appears the rejection may have been intended to be based on lack of written description instead of lack of enablement.

Applicants submit that the specification as filed does provide an adequate written description of the method step of providing marketing material that includes textual matter. For

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example, page 4, lines 14-17 state:

To reduce the time and effort required by the representative to participate in the marketing project, the personalized listings may be delivered in a format that aids the representatives in preparing envelopes, post cards, letters, marketing materials, e-mails, etc.

Page 15, line 30 through page 16, line 6 states:

For example, to help create personalized letters or marketing materials, the personalized listing may be provided in a format that is compatible with a merge function of an application program such as Microsoft Word®. In this format, the representative can merge the names, addresses and/or other fields into personalized letters or marketing materials.

Page 16, lines 15-18 states:

The dialog box 213 of Figure 6 displays various compliant marketing documents that have been developed for the “Uncover Variable Annuity sales in your own Business immediately” marketing project. The representative may download any of these documents via button 214.

Applicants submit that one of ordinary skill in the art, upon reviewing the above specific teachings in the specification, would understand that the marketing materials may include “textual matter”. Additionally, MPEP 2163.02 states:

The subject matter of the claim need not be described literally (i.e., using the same terms or in haec verba) in order for the disclosure to satisfy the description requirement.

Applicants submit that while the specification may not explicitly recite the specific phrase “textual matter”, one of ordinary skill in the art would understand that “textual matter” can be included in the description of the marketing material. Notably, the phrase “textual matter” is included in the *WordNet® 2.0* dictionary as “n : the words of something written;...” (see, “textual matter.” *WordNet® 2.0*. Princeton University. 08 Nov. 2006. <[Dictionary.com http://dictionary.reference.com/browse/textual matter](http://dictionary.reference.com/browse/textual%20matter)>). Thus, Applicants do not believe that it can readily be argued that the phrase “textual matter” would not be understood by one skilled in

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the art. Further, Applicants submit that providing marketing material in "textual matter" format would not have required undue experimentation and is thus adequately described in the specification to satisfy the enablement requirements of 35 U.S.C. § 112, first paragraph. Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 1-6, 8-26, and 28-36 are rejected as failing to comply with the enablement requirement for reciting "customized." Applicants respectfully traverse the rejection. As stated above, the test of enablement according to MPEP 2164.01 is whether the disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention, and whether the experimentation needed to practice the invention undue or unreasonable. Applicants submit that the disclosure provides sufficient information to enable one skilled in the art to provide a customized listing of customers to selected representatives, where each of the customized listings includes a listing of the selected customers that the particular representative represents, as is recited in independent claim 1. The claim itself provides a definition of "customized" listing of customers as including a listing of the selected customers that the particular representative represents. Applicants submit that one of ordinary skill in the art would understand the meaning of "customized" in the context of the claim and that no undue or unreasonable experimentation would be required for one to perform the claimed methods.

Additionally, the disclosure as filed recites, for example, at page 9, lines 13-17:

Once defined, and in the illustrative embodiment, the marketing project parameters may be run against the information in the database 30a to identify selected customers. Once identified, the customers may be sorted by user 54a, 54b and 54c, if desired, and a personalized listing of identified customers can be provided to each user 54a, 54b and 54c.

and at page 21, lines 9-11, "Step 308 allows those firm representatives to obtain a personalized listing of the identified customers that he/she represents." Applicants submit that the disclosure as filed provides adequate enablement for one of ordinary skill in the art to perform the claimed methods including the step of providing a "customized" listing of customers that includes a

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listing of the selected customers that the particular representative represents, as is recited in the claims. As stated above, the subject matter of the claim need not be described literally (i.e., using the same terms or in *haec verba*) in order for the disclosure to satisfy the description requirement (MPEP 2163.02). Applicants submit that while the specification may not explicitly recite "customized", and in fact recites the term "personalized", one of ordinary skill in the art would understand that the "customized" or "personalized" listing of customers includes those customers selected based on the project parameters, where the customers are also represented by the particular representative.

Applicants submit that the claims and specification satisfy both the enablement and written description requirements of 35 U.S.C. § 112, first paragraph. Reconsideration and withdrawal of the rejections are respectfully requested.

Rejection under 35 U.S.C. § 112, second paragraph

Claim 11 is rejected as being indefinite for reciting "and/or" which is unclear and indefinite. The Examiner has interpreted the phrase to mean "or". Applicants respectfully traverse the rejection. Applicants submit that one of ordinary skill in the art understands that "and/or" is merely a shortened way of expressing two specific ideas. In claim 11, one of ordinary skill in the art would understand the phrase "and/or" to clearly mean the method step is either (1) monitoring one of how many or which of the customers that were provided marketing material about the product actually purchased the product from their representative, or (2) monitoring both how many and which of the customers that were provided marketing material about the product actually purchased the product from their representative. Applicants submit that the scope of the claimed subject matter is clear. MPEP 2173.04 states:

Breadth of a claim is not to be equated with indefiniteness. In re Miller, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph.

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Applicants submit that while the use of "and/or" in claim 11 may broaden the scope of the claim, the scope of the subject matter embraced by the claim is clear.

Claims 1, 10, 25, and 31 are rejected as being indefinite for reciting "customized" which is unclear and indefinite. Applicants respectfully traverse the rejection. As detailed above, Applicants submit that the word "customized" is easily understood by one of ordinary skill in the art, particularly in view of the present specification. Also, breadth of a claim is not indefiniteness. Additionally, claims 1, 10, and 25 recite the specific content of the customized listing, and one of ordinary skill in the art would clearly understand the meaning of "customized" in claim 31 in the context of the claim and based on the ordinary usage of the word.

Applicants submit that the recitations in the claims of "and/or" and "customized" are clear and definite and meet the requirements of 35 U.S.C. § 112, second paragraph. Reconsideration and withdrawal of the rejections are respectfully requested.

Rejection under 35 U.S.C. § 103(a)

Claims 1-18, 20-30, and 36 are rejected as being unpatentable over Melchione et al. (US 5,930,764). Applicants must respectfully traverse this rejection. In the body of the rejection, the Examiner asserts that Melchione teach providing a customized listing of customers to at least selected representatives, wherein each of the customized listings includes a listing of the selected customers that the particular representative represents, but does not provide any indication of where in Melchione et al. such a teaching is found. The Examiner later acknowledges that Melchione et al. fail to teach customized lists.

Applicants submit that the Examiner's second statement is correct because Melchione et al. do not appear to teach customized lists. The Examiner also asserts that Melchione teach, at column 8, lines 61-66, the steps of generating marketing material for the marketing project and providing the marketing material to each of the representatives that receives a customized listing, where the branch managers request leads, and the leads, or marketing material would be specific to that branch, i.e. the branch represents a certain portion of the leads, based upon geography or

types of transactions. Applicants respectfully disagree with the Examiner's interpretation of Melchione.

The portion of Melchione cited by the Examiner actually states:

A plurality of micromarketing workstations may be used within the micromarketing center to respond to requests from branch managers for lists of leads for selected sales programs (i.e., marketing campaigns for new or existing products or services offered by the financial institution).

Column 8, lines 61-66. Applicants submit that Melchione simply teach that branch managers request lists of leads for certain sales programs. Melchione then teach:

The branch managers receive the list of leads generated by the micromarketing center and electronically load the leads into the CCIS workstations for distribution among selected personal bankers within the branch. The branch managers assign the leads to the personal bankers most qualified to handle the leads, or based on the workload and availability of the personal bankers.

(Emphasis added; see column 9, lines 46-52). Melchione thus teach that the personal bankers (representatives) receiving a list of leads based on workload or availability. Melchione clearly do not teach providing a customized listing of customers to the personal bankers, where the customized listing includes a listing of selected customers that that personal banker represents. The Examiner asserts that customers that are pulled up in a query by each banker would be those that the banker represents since they are in his territory. The Examiner appears to be equating the geographical region where a bank customer lives and his/her proximity to a bank branch with that person being "represented" by a particular personal banker. Applicants submit that such an interpretation is contrary to the ordinary use of the term "represent". Applicants submit that one of ordinary skill in the art would understand that merely because a person lives in close proximity to a particular bank branch does not mean that person is represented by the branch or a particular banker at that branch. The skilled artisan would understand that a person's bank preference involves many factors, not just location. Additionally, even if a person were a customer of a particular bank branch, he/she is not necessarily represented by any particular personal banker, without some prior established relationship. This is clear from the above quoted teaching of

Melchione that branch managers assign leads to a personal banker based his/her qualifications or workload and availability. There is no indication that the bank customers in the system of Melchione are represented by any particular personal bankers (representatives).

Additionally, Melchione teach the branch managers requesting a listing of customers, and does not appear to teach or suggest a banker (representative) making the query. Thus, Melchione does not appear to teach or suggest a method in which a customized listing of customers is provided to selected representatives, where each customized listing includes a listing of those customers that were selected based on marketing project parameters and which customers are also represented by that particular representative (banker).

The Examiner asserts that Melchione teaches determining which or how many of the customers that were sent the marketing material by their representatives actually purchased the product, pointing to column 41, lines 63-67 for support. The Examiner appears to be equating Melchione's teaching that "sales tracking component provides an indication of the amount of revenue generated for the financial institution by each personal banker" with the claimed method step of determining which or how many of the customers that were sent the marketing material by their representatives actually purchased the product. Applicants respectfully disagree with this interpretation.

The claimed method step involves two separate determinations: (1) those customers that were sent the marketing material, and (2) which or how many of the customers in (1) actually purchased the product. Applicants submit that Melchione appears to merely determine the amount of revenue generated by each personal banker. Such a step clearly does not involve first determining which customers were actually sent marketing material, and then determining which or how many of those customers actually purchased a product. Melchione's method appears to only determine the resulting revenue generated by a banker, without regard to how many customers received marketing material or how many of those customers actually purchased the product. Applicants submit that the Examiner's interpretation of Melchione is contrary to the specific teachings of Melchione and is thus improper.

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The Examiner also asserts that the system of Melchione provides detailed access to the sales transactions for each banker and one can view the sales results for the various campaigns to track the performance and make adjustments in the campaign as needed. It appears the Examiner is asserting that one could modify the specific method steps taught by Melchione to achieve the specific method steps recited in the instant claims. MPEP 2143.01 III states:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)... Although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.' 916 F.2d at 682, 16 USPQ2d at 1432.).

Applicants submit that just because one could view the sales results of Melchione and choose to perform the claimed method steps does not render the claims obvious because Melchione does not appear to provide any suggestion or motivation to make such changes. The Examiner has not provided any indication of why one of ordinary skill in the art would have been motivated to make the changes to the method of Melchione needed to achieve the claimed method.

The Examiner acknowledges that Melchione fails to teach customized lists, but asserts that the act of querying a database to select customers in your assigned territory that generates a list of leads is deemed equivalent as it performs an identical function in substantially the same manner with substantially the same results. Applicants respectfully disagree. The claimed step requires providing a customized listing of customers where the customized listing includes a listing of the selected customers that the particular representative represents. Thus, the listing of customers is customized to a particular representative in that the listing includes those customers actually represented by that particular representative.

Applicants submit that Melchione does not teach any method steps that perform the identical function in substantially the same manner with substantially the same results. As noted above, Melchione teaches a branch manager querying a database to select customers based on suitability for a sales campaign, and then assigning the leads to personal bankers most qualified

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to handle the leads or based on the workload and availability of the personal bankers. See column 9, lines 46-52. The function of this step appears to be distributing leads to personal bankers according to either the bankers' qualifications or workload/availability. The function of the claimed method step is to provide a listing of customers represented by a representative where those customers are selected based on marketing project parameters. The customers on the claimed customized list thus have two characteristics: (1) they are already represented by the representative, and (2) they meet the marketing project parameters. The customers on the list of Melchione have different characteristics: (1) they apparently live near the branch bank, and (2) they meet the sales campaign criteria.

Further, the results of the claimed method step of providing a customized listing of customers and the method step of receiving a list of leads taught by Melchione are not the same. The result of the claimed method step is that a listing is provided to a representative including a list of his/her customers who match the marketing project parameters. The result of Melchione appears to be a listing of customers who live in the geographic area of the bank branch and who match the sales campaign parameters. As discussed above, Applicants submit that just because a person lives near a bank branch does not mean he/she is represented by a particular personal banker at that branch. One of ordinary skill in the art would clearly understand that the phrase "customers that the particular representative represents" denotes a pre-existing relationship between the customer and representative. The only relationship that the Examiner asserts as existing in the system and method of Melchione is that the customer lives near the bank branch. Applicants submit that these relationships are not equivalent and that the results of the claimed method steps and the method steps of Melchione are not equivalent.

The Examiner also asserts that it would have been obvious to modify the lead system of Melchione with a customizable feature to provide means for segregating customers to the optimal sales person, by product line or geography. The Examiner has not, however, provided any indication of why one would have been motivated to make such a modification to the system or methods of Melchione. As discussed above, just because one could modify a reference to

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achieve the claimed subject matter, does not provide the motivation necessary for a *prima facie* case of obviousness. The only motivation or suggestion for modifying Melchione appears to be found in Applicants' specification, which is clearly improper. Reconsideration and withdrawal of the rejection are respectfully requested.

Regarding claims 2 and 3, the Examiner asserts that the system of Melchione "provides detailed access to the sales transactions for each banker and one can view the sales results for the various campaigns to track the performance and make adjustments in the campaign as needed." Emphasis added; see page 8, lines 11-13 and page 9, lines 1-3 of the Office Action. As discussed above, the mere fact that one could modify a reference is not proper motivation to make the modification and is not proper grounds for obviousness.

Regarding independent claim 10, the Examiner asserts that Melchione teaches the concept of "representatives" and their contact with customers wherein the branch workstations are deemed equivalent to the term "representative" as they perform the identical function in substantially the same manner and produce substantially the same results. Applicants respectfully disagree. Applicants submit that one of ordinary skill in the art, upon reading the claims and specification would not equate the "representatives" recited in the claims with the branch workstations taught by Melchione. The claimed method includes the step of providing a customized listing to at least some of the representatives, each of the customized listings including the portion of the selected customers that are represented by the particular representative. Applicants do not understand how a branch workstation can be deemed to "represent" a customer, or how a branch workstation can "elect to provide marketing material...wherein the marketing material is personalized to at least appear to be from the branch workstation. Applicants are particularly unsure how a customer would purchase a product from a branch workstation, as would be recited in claim 13. Applicants submit that the branch workstations do not perform the identical function to produce substantially the same results as the claimed representative. If this rejection is maintained, Applicants respectfully request the Examiner provide a detailed explanation of how the branch workstation would perform the

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specific method steps recited in independent claim 10 and the claims dependent thereon.

Regarding the dependent claims, the Examiner asserts that Melchione teach a system and method that can generate various reports. As discussed above, the mere fact that one could modify a reference is not proper motivation to make the modification and is not proper grounds for obviousness.

Regarding independent claim 25, the Examiner asserts that Melchione teach:

providing a notice announcing the marketing project to one or more of the representatives (); at least some of the representatives reviewing the notice and requesting a customized listing that includes a listing of the portion of the selected customers that are represented by the representative, and determining a marketing project appeal indicator by monitoring how many representatives reviewed the notice and requested a customized listing ().

The Examiner has not provided any indication of where in Melchione the above teachings are found, as evidenced by the empty parentheses. Applicants have not found such teaching in Melchione. The Examiner also asserts that Melchione's teaching of tracking the results of the sales promotion inherently means the representatives were notified of the promotion since they are contacting customers to sell it. Applicants respectfully submit that the bankers merely being notified of a promotion does not teach the claimed method step of at least some of the representatives reviewing a notice and requesting a customized listing of customers.

The Examiner also asserts that the marketing appeal indicator of claim 25 is a measure of the performance of the marketing plan and is equivalent to Melchione's tracking the performance of the campaign since it performs an identical function in substantially the same manner with substantially the same results. Applicants respectfully disagree. Claim 25 recites a method requiring specific method steps. The steps of capturing daily sales information and viewing sales results for various campaigns taught by Melchione (column 10, lines 1-6) do not perform an identical function or have substantially the same results as the claimed method step of determining a marketing project appeal indicator by monitoring how many representatives reviewed the notice AND requested a customized listing. Melchione does not teach the steps of

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monitoring bankers who review a notice. Instead, Melchione appears to teach the marketing material being provided automatically from the micromarketing center. Further, Melchione does not appear to teach or suggest the step of monitoring how many representatives requested a customized listing of customers. As stated above, Melchione appears to teach the micromarketing center distributing leads to bankers according to branch managers' directions. Melchione thus does not teach or suggest the specific method steps recited in independent claim 25.

As discussed above, Melchione do not appear to teach representatives requesting customized listings. Thus, Melchione cannot be seen to teach or suggest determining a marketing project appeal indicator by monitoring how many representatives reviewed the notice and requested a customized listing. Further, Melchione does not appear to teach or suggest the elements of claims dependent on 25.

Dependent claim 26 specifies that the customized listing of selected customers is provided to one or more of the representatives upon initiation by the representative. The Examiner asserts that Melchione teach, in FIG. 1A, the Micromarketing centers as requesting information from the database to obtain the customer information, and asserts that the micromarketing center is the "representative." Independent claim 25, from which claim 26 depends, recites "each representative represents a portion of the customers", and the Examiner previously asserted that the personal bankers of Melchione are equivalent to the "representatives" in the claims. Applicants submit that the micromarketing center taught by Melchione is not equivalent to the "representatives" in the claimed methods because Melchione teaches the micromarketing center as providing information to the personal bankers, who then contact customers. Melchione does not appear to teach or suggest the personal bankers initiating a customized listing of customers to be sent to them. Melchione thus does not appear to teach or suggest the elements of claim 26.

Regarding claim 29, the Examiner asserts that Melchione's teaching that leads are distributed among selected bankers within the branch anticipates the method step of providing a

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customized listing of selected customers to a particular representative where the list only includes customers that the particular representative represents. Applicants respectfully disagree. As noted above, Melchione teaches the branch manager determining which banker gets which leads based on which banker is most qualified to handle the leads or based on the workload and availability of the bankers. See column 9, lines 49-52. Melchione thus appears to teach a branch bank with a set of customers, and the bank managers decide which customers are to be handled by certain bankers, where the particular set of customers being contacted by a particular banker changes depending the banker's availability or qualifications. Melchione does not appear to teach a method in which each customer is represented by a particular representative, and the representative receives a listing of customers for which the marketing material is particularly relevant, where the only customers on the list are those that the representative already represents, as in claim 29. Thus, while all of selected customers on the list generated based on the marketing project parameters are customers of the business, a subset of those customers are represented by a particular representative, and the method of claim 29 states that the customized listing of customers provided to a particular representative includes only those customers already represented by that representative. Melchione does not teach or suggest such a method.

Regarding independent claim 36, the Examiner asserts that the claim recites the same limitations as claims 1 and 3 and is therefore subject to the same art rejections. Melchione does not appear to teach or suggest each and every element of independent claim 36 for at least the reasons set forth above. Additionally, claim 36 recites the step of providing a customized listing of customers, wherein customers are represented by a single representative. For at least the reasons set forth above, Melchione does not appear to teach customers represented by any particular representative and thus cannot be deemed to teach customers represented by a single representative.

For at least the reasons set forth above, Melchione does not appear to teach or suggest each and every element of independent claims 1, 10, 25, or 36, or the claims dependent thereon. Reconsideration and withdrawal of the rejection are respectfully requested.

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Claims 19 and 31-35 are rejected as being unpatentable over Melchione in view of 17 CFR Part 248, which is a financial services regulation related to Privacy of Consumer Information. Applicants respectfully traverse the rejection. As discussed above, Melchione does not appear to teach or suggest the basic elements of independent claim 10, from which claim 19 depends. 17 CFR Part 248 does not appear to provide what Melchione lacks, thus any combination of the references also fails to teach or suggest each and every element of dependent claim 19.

Additionally, there does not appear to be any motivation for combining the teachings of Melchione and 17 CFR Part 24. The Examiner asserts that the motivation to combine the references is the fact that federal law requires adherence to the regulations. Applicants submit that the mere presence of regulations relating to consumer privacy does not provide any motivation, guidance or suggestion for one of ordinary skill in the art to modify the database of Melchione.

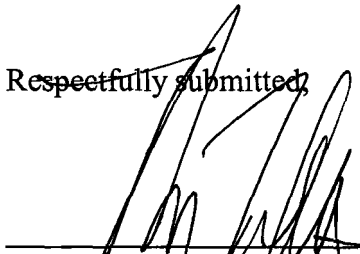
Independent claim 31 recites in part, the steps of generating marketing material, wherein at least part of the marketing material includes textual matter, checking the marketing material for compliance, and representatives providing the compliant marketing material to at least some of the customers on their customized listing of selected customers. Melchione does not appear to teach a method in which textual marketing material is checked for compliance, providing the compliant marketing material and a customized listing of selected customers to at least some of the representatives (bankers), and then bankers providing the textual marketing material to at least some of the customers on their customized listing of selected customers. The 17 CFR Part 24 regulations do not provide what Melchione lack, thus any combination of Melchione and the regulations also fails to teach or suggest each and every element of independent claim 31 or the claims dependent thereon. Withdrawal of the rejection is respectfully requested.

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Reconsideration and reexamination are respectfully requested. It is submitted that, in light of the above remarks, all pending claims are now in condition for allowance. If a telephone interview would be of assistance, please contact the undersigned attorney at 612-359-9348.

Respectfully submitted,

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